

REMARKS

Claims 1-5, 7-34 and 36 are now pending in the application, with claims 1, 21 and 30 now being the independent claims. Reconsideration and further examination are respectfully requested.

In the amendments above, previously pending independent claims 1 and 30 have been amended based on the Decision from the Board of Patent Appeals and Interferences (BPAI) to include a limitation that encompasses, but is somewhat broader than, the limitations in dependent claims 7 and 8. Support for this amendment can be found, e.g., at page 4 lines 27-30 of the Specification. In addition, previously pending claim 21 simply has been rewritten into independent form; no changes have been made to it. Finally, claims 6 and 35 have been canceled, and dependent claims 5, 9, 10, 33 and 34 have been amended based on the amendments of independent claims 1 and 30.

Prior-Art Rejections

In the Office Action, claims 6 and 35 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 4,658,514 (Shin) in view of U.S. Patent No. 2,793,136 (Root) and U.S. Patent No. 2,663,097 (Giese); claim 7 was rejected under § 103(a) over Shin in view of Root and U.S. Patent No. 1,499,785 (Regula); claim 8 was rejected under § 103(a) over Shin in view of Root and U.S. Patent No. 2,103,884 (Wentworth); claims 21-23 were rejected under § 103(a) over Shin in view of Root, U.S. Patent No. 2,029,361 (Diller), U.S. Patent No. 4,050,168 (Pace) and U.S. Patent No. 2,144,330 (Farrington); and claim 33 was rejected under § 103(a) over Shin in view of Root and U.S. Patent No. 4,356,643 (Kester). Withdrawal of these rejections is respectfully requested for the following reasons.

Claims 6 and 35 have been canceled above. Accordingly, the rejection of those claims is now moot.

Claim 7 recites, in addition to the limitations in its base claim, that the recited small particles comprise at least one of natural and synthetic leather. The Office Action acknowledges (and the BPAI previously determined) that no permissible combination of Shin and Root would have disclosed or suggested this feature of the invention. To make up for this deficiency, the Office Action asserts that

Root '156 discloses that a variety of particles can be used for forming the slip resistant surfaces. Regula '784 discloses that it is desirable to make use of old leather, or scrap leather by chopping it in small particles and use it in soles and heels of shoes for high durability and flexibility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of Shin '514-Root '514 out of leather as taught by Regula '784 for better durability and flexibility, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

However, as stated in the Office Action, Regula merely notes that its composite material of leather particles and rubber provides, "high durability and flexibility". Regula says nothing at all about its composite material providing increased traction, and even the Office Action does not appear to assert that it does. Accordingly, replacing Root's hard resin granules (which are used only on the lower extending portions in the asserted combination of Shin and Root) with leather would not have been obvious and presumably would have defeated Root's stated purpose of providing increased traction.

As stated on page 10 of the BPAI Decision, "the Examiner has not adequately shown that those of skill in the art would have recognized leather or rubber particles as an obvious

substitution for the ‘angular or rough’ particles used by Root.” It is noted that current claim 7 has the exact same form in which it was considered by the BPAI.

At the same time, simply replacing an entire layer of Shin’s shoe sole with Regula’s composite layer would not have resulted in the presently claimed feature in which a plurality of small particles is bonded to at least some of the lower extending portions, but each of the plurality of indentations is predominantly uncoated with such small particles. In short, there simply would have been no motivation to incorporate Regula’s composite material into any permissible combination of Shin and Root in any manner that would have resulted in the combination of features recited in claim 7 (i.e., selectively placing natural or synthetic leather particles as claimed).

Accordingly, claim 7 is believed to be clearly allowable over the applied art.

Claim 8 recites, in addition to the limitations in its base claim, that the small particles comprise at least one of natural and synthetic rubber. The Office Action acknowledges (and again the BPAI previously determined) that no permissible combination of Shin and Root would have disclosed or suggested this feature of the invention. In order to make up for this deficiency, the Office Action asserts that

Root ‘156 discloses that a variety of particles can be used for forming the slip resistant surfaces in the article of footwear. Wentworth ‘884 discloses that it is desirable to use as filler material, powdered or granular material with resilient character such as ground up tire carcass, or other rubber waste in soles of shoes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of Shin ‘514-Root ‘136 out of rubber as taught by Wentworth ‘884 for resilient characteristic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In this regard, Applicant notes that Wentworth, “relates broadly to a resilient insert or layer between the insole of a shoe and the outer sole thereof.” Column 1 lines 1-3 of Wentworth. More specifically, Wentworth’s “resilient material forms a cushion between the insole and the outer sole.” Column 1 lines 12-13 of Wentworth.

In other words, the purpose of Wentworth’s structure is to provide cushioning in a middle layer of the sole, not additional traction at the bottom of the sole. In fact, Wentworth says nothing at all about its cushioning layer providing increased traction, and even the Office Action does not appear to assert that it does. Therefor, replacing Root’s hard resin granules (which are used on the lower extending portions in the asserted combination of Shin and Root) with rubber particles presumably would have defeated Root’s stated purpose of providing increased traction.

As stated on page 10 of the BPAI Decision, “the Examiner has not adequately shown that those of skill in the art would have recognized leather or rubber particles as an obvious substitution for the ‘angular or rough’ particles used by Root.” It is noted that current claim 8 has the exact same form in which it was considered by the BPAI.

At the same time, simply replacing a layer of Shin’s sole with Wentworth’s cushioning layer would not have resulted in the presently claimed feature in which a plurality of small particles is bonded to at least some of the lower extending portions, but each of the plurality of indentations is predominantly uncoated with such small particles. In short, there simply would have been no motivation to combine the applied-art references in any permissible manner that would have resulted in the combination of features recited in claim 8.

Accordingly, claim 8 is believed to be clearly allowable over the applied art.

As noted above, claim 21 is substantively the same as when considered by the BPAI (having just been rewritten into independent form). It recites, in addition to the limitations of its

previous base independent claim 1, that the small particles are bonded using a temporary adhesive that allows the particles to wear off during normal outdoor use. At least this feature of the invention is not disclosed or suggested by the applied art.

With respect to it, the Office Action first asserts,

The combination of Shin '514 and Root '136 discloses that the small particles are bonded to the bottom of the sole using an adhesive. The "temporary adhesive" of claim 21 has no reference point and is met by the adhesive of Shin '514 and Root '136, since the particles of Shin '514 and Root '136 will eventually wear off.

However, there are several problems with these arguments.

First, the "reference point" that the Office Action asserts is missing is that the particles wear off during normal outdoor use.

Second, the foregoing argument that the presently recited temporary adhesive limitation, "is met by the adhesive of Shin '514 and Root '136, since the particles of Shin '514 and Root '136 will eventually wear off," is tantamount to asserting that the recited term "temporary" is so broad as to encompass everything. That is, anything eventually will wear off. Therefore, this argument is equivalent to arguing that the recited term "temporary" should be completely read out of the claim. Any claim construction that simply ignores express claim terms clearly would be inappropriate.

Third, Root clearly contemplated that its attached hard resin granules would be a *permanent* part of its outsole (i.e., lasting the entire life of its shoe), not that they would be temporary and would wear off during normal outdoor use. Use of a temporary adhesive through which such granules would wear off after ordinary use certainly would have defeated the goal that Root is trying to achieve, i.e., resistance to slipping.

Fourth, one of the main purposes of Root's approach appears to be to more fully integrate its resin particles into the sole of the shoe, thereby preventing them from becoming dislodged. See, e.g., column 1 line 51 through column 2 line 9, particularly column 2 lines 2-4 which states, "In none of these cases is there a sharp change in hardness which might localize separation stresses." In other words, a main concern of Root was to enhance permanency. Using any kind of temporary adhesive would have been directly contrary to this goal.

Finally, it is noted that the BPAI studied the present claim language and did not conclude that the term "temporary" could in fact be read out of claim 21, or even that it was so broad as to encompass Root's structure. If it had, the BPAI would not have reversed the Examiner's rejection over the asserted combination of Shin and Root (and one additional prior-art reference).

The Office Action also asserts, "Diller '361, Pace '168 and Farrington '330 have been merely introduced as evidence that show that adhesive materials have different degrees of adhesiveness." However, it is unclear why this assertion is made because, even if true, it does not change any of the points set forth above. For example, when studying the present claim language, the BPAI certainly knew that different adhesive materials have different degrees of adhesiveness. This would not have been some revelation that would have altered its conclusion. Similarly, knowledge of such a general proposition would not have motivated any one of ordinary skill in the art to modify the asserted specific combination of Shin and Root to attach Root's hard resin granules with a temporary adhesive material, instead of embedding them in a molecularly similar resin matrix (for the stated purpose of making their attachment more integral).

More specifically with respect to these references, Diller apparently uses an adhesive material for an intermediate manufacturing step and has no relation to the other applied art or to

the presently claimed feature. Pace apparently uses a pressure-sensitive adhesive for decorative purposes and, therefore, it is unclear how it could be combined with the other applied-art references. As noted in the Office Action, Farrington merely discloses the use of a temporary adhesive for attaching a sheet to an insole; it does not seem to have any relation to the other applied art or to the presently claimed feature.

For at least the foregoing reasons, independent claim 21 is believed to be clearly allowable over the applied art.

Claims 22 and 23 recite more specific limitations regarding the presently recited temporary adhesive. Apparently as to these features, and with reference to Diller, Pace and Farrington, the Office Action asserts

when applying the knowledge of the adhesive to the amount of time “days” and “weeks” in claims 22 and 23, it would depend on the amount of time desired for the particles to remain on the shoe, and would have been obvious to one of ordinary skill in the art to select the adhesiveness of the adhesive to be used to cover a certain time-wear parameter, since the amount of time, “days” or “weeks” are result determined parameters and such would have been well within the expedient and obvious to the ordinary skilled artisan.

However, as noted above, there simply is no motivation whatsoever in any of the applied art to limit, in any manner whatsoever, the duration that the particles are to remain on the shoe, much less as specifically recited in claims 22 and 23. To the contrary, as noted above, one of Root’s main goals is to make its granules as permanent as possible. Accordingly, there would have been no motivation to modify the applied art as argued in the Office Action.

For at least these additional reasons, claims 22 and 23 are believed to be clearly allowable over the applied art.

Independent claims 1 and 30 have been amended above to include limitations similar to (although somewhat broader than) the limitations expressly recited in dependent claims 7 and 8.

Accordingly, for similar reasons to those set forth above, independent claims 1 and 30 also are believed to be allowable over the applied art.

Claim 33 has been amended above based on the amendment made to independent claim 30. Accordingly, the rejection of claim 33 in its previous form is now believed to be moot. In addition, there does not appear to be anything in the applied art that would have disclosed or suggested the limitation recited in amended claim 33.

Provisional Obviousness-Type Double-Patenting Rejection

In the Office Action, claims 6-8, 21-23, 33 and 35 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-20 of copending U.S. Patent Application Serial No. 11/530,419 (the '419 application). Withdrawal of this rejection is respectfully requested for the following reasons.

Independent claims 1 and 21 of the present application recite the feature that a plurality of small particles is bonded to at least some of the lower extending portions, but each of the plurality of indentations is predominantly uncoated with such small particles. Similarly, independent claim 30 of the present application recites the feature that a plurality of small particles is bonded differentially to different areas of the bottom surface of a shoe, with each of a plurality of the ground-contacting portions being coated more than each of the plurality of indentations.

Neither of these features is suggested by the claims in the '419 application. To the contrary, independent claim 1 of the '419 application recites that natural fibers are bonded to at least some of the indentations, but the lower-extending portions predominantly are uncoated with such natural fibers. Similarly, independent claim 11 of the '419 application recites that natural



fibers are bonded to at least some of the indentations in the base material, but the lower-extending portions predominantly are uncoated with said natural fibers.

In other words, the claims of the '419 application recite features that are largely the opposite of what is claimed in the present application. It is unclear how the present claims possibly could have been obvious in view of the claims of the '419 application.

Accordingly, withdrawal of this rejection is respectfully requested.

#### Obviousness-Type Double-Patenting Rejection

Claims 6-8, 21-23, 33 and 35 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-19 of U.S. Patent No. 7,191,549 (the '549 patent).

Withdrawal of this rejection is respectfully requested for the following reasons.

Independent claims 1 and 30 of the present application, as amended above, recite that the small particles comprise at least one of wood, paper, natural leather, synthetic leather, natural rubber and synthetic rubber. In addition, independent claim 21 recites that the small particles are bonded using a temporary adhesive that allows the particles to wear off during normal outdoor use.

These features are not even remotely suggested by the claims of the '549 patent. Rather, the claims of the '549 patent recite the use of individual fabric fibers.

Accordingly, withdrawal of this rejection is respectfully requested.

#### Additional Remarks

The claims in this application that are not specifically addressed above depend from the claims that are discussed above, and are therefore believed to be allowable for at least the same reasons. Because each dependent claim also defines an additional aspect of the invention,

however, the individual reconsideration of each on its own merits, in light of the remarks set forth above, is respectfully requested.

In order to sufficiently distinguish Applicant's invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and Applicant's invention. However, no attempt has been made to categorize each novel and unobvious difference. Applicant's invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

If there are any fees due in connection with the filing of the currently submitted papers that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 502490. If an extension of time under 37 C.F.R. 1.136 is required for the filing of the currently submitted papers and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account.

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Respectfully submitted,

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